THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROMI JUSO, YUKIHIKO HAIKAWA,
and YUKIHARU HOSONO

Appeal No. 96-1421
Application 08/065,773

HEARD: 17 September 1997

Before THOMAS, JERRY SMITH, and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-15. (Paper 14.) No other claims are pending. (Paper 7 at 1.) We reverse.

FINDINGS OF FACT

We have reviewed the record in its entirety in light of the arguments of Applicants and the examiner. Our decision presumes familiarity with the entire record. A preponderance of the evidence of record supports each of the fact findings.

1. The application is entitled "Information reproducing apparatus by which reading operation from recording medium is

controlled based on amount of data in memory". The subject matter of the invention is an apparatus and a method for reading out and time-base expanding information from a recording medium. (Paper 1 at 1.)

2. An example would be a portable mini disk (MD) player used for audio recordings. Information can be read from an MD into a semiconductor memory (e.g., random access memory or RAM) much faster than it can be expanded and read out from the RAM. (Paper 1 at 1.) The data being expanded is stored in the semiconductor memory. (Paper 1 at 2.)

3. The difference in the output rate of the disk and the output rate of the semiconductor memory permits the MD to be made "shock proof", i.e., resistant to physical shocks and other disruptions. Since disk output is much faster, the disk-reading apparatus can use the idle time (time spent waiting for the semiconductor memory to catch up) to correct mistakes in position caused by disruptions. (Paper 1 at 2-3.)

4. Applicants note that power for portable MD players usually comes from batteries. Hence, power conservation is a concern. (Paper 1 at 3-4.) They propose to address this problem by turning the power to the disk-reading apparatus off during at least some of the idle time. (Paper 1 at 5.)

5. The examiner finally rejected claims 2-4 under 35 U.S.C. § 112 (Paper 7 at 4), but has since withdrawn this rejection (Paper 12).

6. The examiner finally rejected claims 1-15 under 35 U.S.C. § 103 (Paper 7 at 5) as unpatentable over the following references:

Sako	EP 0 463 183 A1	2 Jan. 1992
Smith et al. (Smith)	5,167,204 (eff. filing date 8 Sep. 1989)	24 Nov. 1992

7. We find, and Applicants' counsel at oral argument conceded, that Sako is essentially identical to Applicants' admitted prior art.

8. Smith teaches a power manager for a laptop computer. (3:13-14.) The power manager monitors the activity of devices in the laptop and deactivates the idle ones to conserve battery power. (3:33-41.)

9. We find that Sako is directed to the same field of endeavor as the subject matter of the invention and that Smith is directed to the problem facing the inventor: reducing power consumption in a battery-powered device by cutting off power to idle devices.

10. Neither reference teaches what claim 12 describes as:

> a control circuit for controlling an amount of power provided by the power supply and consumed by the

> information reproducing apparatus based on an amount of data stored in the memory to be read out.

11. We agree that Smith's teaching of turning off idle devices can properly be applied to Sako's device in order to save power. What we do not see is what would motivate the person having ordinary skill in the art to control power to the disk-reading apparatus based on the contents of Sako's shock-proof memory. One would first have to decide that, despite Sako's stated advantages for using the idle time to maintain track position (8:40-56), that the idle time should instead be used to save power. Second, one would have to decide to use the contents of the shock-proof memory as a guide to the activity of the disk-reading apparatus. Neither of these modifications are taught or suggested.

12. We do not agree with Applicants, however, that Sako teaches away from the claimed invention. The fact that Sako does not contemplate using the idle time for power conservation simply shows that it does not anticipate Applicants' invention. Contrary assumptions in a reference do not, by themselves, establish a teaching away at the time of the invention. In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Indeed, Applicants disclose operating in an exclusively shock-proof mode, which is Sako's mode of operation, as part of their invention. (Paper 1 at 14-15.) Thus, the fact that Sako

continuously, if usually idly, continues to read the disk does not, by itself, teach away from the claimed invention.

13. Secondary considerations and the level of skill in the art are not contested issues in this appeal.

CONCLUSIONS OF LAW

1. All of the independent claims contain some form of control circuit limitation of claim 12. All of the dependent claims necessarily contain this limitation.

2. Since the combined references, read as a whole, would not have taught or suggested the limitation of controlling the power supply based on an amount of stored information, we must conclude that the claimed invention would not have been obvious to a person having ordinary skill in the art at the time of the invention in view of Sako and Smith.

DECISION

The rejection of claims 1-15 under section 103 is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)	

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